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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,482	09/26/2001	Haruyuki Mizuno	2001-1209A	9656

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

8

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/937,482

Applicant(s)

MIZUNO ET AL.

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Specification***

The objection to the disclosure has been withdrawn due to applicant's amendments.

#### ***Claim Rejections - 35 USC § 112***

The rejection of claims 5, 6, 16, and 17 under 35 U.S.C. 112, first paragraph, has been withdrawn due to applicant's amendments.

The rejection of claim 22 under 35 U.S.C. 112, first paragraph, has been withdrawn due to applicant's amendments.

#### ***Claim Rejections - 35 USC § 102***

The rejection of claims 1-5, 7, 9-16, 18, and 20-24 under 35 U.S.C. 102(a) as being anticipated by Mizuno et al. (JP 2000-265526) has been withdrawn due to applicant's arguments.

#### ***Claim Rejections - 35 USC § 103***

The rejection of claims 6, 8, 17, and 19 under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. (JP 2000-265526) has been withdrawn due to applicant's arguments.

The rejection of claims 1-22 and 24 under 35 U.S.C. 103(a) as obvious over Asai et al. (5,599,893) in view of Applicant's admitted prior art (specification, page 8, lines 17-21) has been withdrawn in light of a new rejection.

The rejection of claims 22 and 23 under 35 U.S.C. 103(a) as being unpatentable over Asai et al. (5,599,893) in view of Mizuno et al. (JP 2000-265526) has been withdrawn due to applicant's arguments.

***New Claim Rejections - 35 USC § 103***

Claims 1-10, and 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asai et al. (5,599,893) in view of Bertocchi et al. (6,174,608 B1). Regarding claims 1-10, and 12-21, Asai et al. disclose the instantly claimed composition (as set forth in the previous office action and also noted by applicant in the last response beginning on page 9, fifth and sixth paragraph). Asai et al. disclose a first component (col.3, lines 11-67) and second component (col.4, lines 1-59), mixed together (col.3, lines 4-10). These components are the same as claimed by applicant. Although Asai et al. do not specifically disclose what happens after they combine, it appears this is inherently disclosed in the composition of Asai et al. because the

components of Asai et al. are the same as applicant's, and the same components would have yielded a composition with the inherently same characteristics. If not inherent, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the composition of Asai et al. to have achieved the instantly claimed inherent characteristics, because the composition of Asai et al. is at least similar to that of applicant's, and at least similar materials would have yielded a product with at least similar inherent characteristics. It is not clear why the composition of Asai et al., which is the same as applicant's, would also not behave to achieve the instantly claimed characteristics. Applicant has amended the claims (claims 1 and 12) to include a surface that is repeatedly wetted and dried. Asai et al. disclose a surface to be treated that is exposed to rain (col.7, lines 9-15). This is a surface that is repeatedly wetted and dried. Applicant has also amended the claims to include sanitary chinaware (claims 1 and 12). Bertocchi et al. provide the general teaching that sanitary chinaware is known in the art to be composed of ceramic (col.5, lines 42-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for Asai et al. to have applied their composition to a ceramic surface, such as sanitary chinaware, because Bertocchi et al. teach that sanitary chinaware is ceramic.

Regarding claim 22, Asai et al. do not appear to disclose applying the composition to a stained surface. Asai et al. do disclose applying the composition to a variety of surfaces, including various glass articles, porcelain, tiles, and plastic materials, (col.7, lines 9-15). It is the examiner's position that it would have been within the skill of the art to that these substrates can be stained, either decoratively or

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otherwise, before application of the composition of Asai et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the composition of Asai et al. to a variety of substrates, including a substrate that can be decoratively stained or otherwise, because Asai et al. disclose applying the composition to a variety of substrates produces a waterproof and stainproof substrate resulting in a higher quality product.

Regarding claim 23, Asai et al. appear to disclose reproducing a hydroxyl group on the surface by additional wetting (col.7, lines 9-15).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan 

May 8, 2003



Robert Dawson  
Supervisory Patent Examiner  
Technology Center 1700